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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,824	02/11/2002	Minyu Li	1149.1103101	6363

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EXAMINER
HOWARD, JACQUELINE V

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 02/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,824	LI ET AL.	
	Examiner	Art Unit	
	Jacqueline V. Howard	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-30,33,34 and 38-42* is/are allowed.

6)☒ Claim(s) *31,32 and 43-82* is/are rejected

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31, 32, 35 to 37, 63, 64, 73 to 75 and 76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31, 32, 64 and 75 are composition claims improperly dependent on a method claim.

Claim 63 is a method claim improperly dependent on a composition claim.

Claims 35 to 37, 73 and 76 recites the limitation "the aqueous lubricant" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claims 59-61 recites the limitation "the container" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43 to 54, 58, 63 to 66, 70 to 72 and 77 to 81 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shepley et al (4,288,331).

The reference teaches a lubricant composition comprising a fatty acid and a derivative of a polyalkylene glycol polymer. See especially col. 2 lines 8 to 14, col. 2 line 55 and col. 2 lines 60 to 68 for a composition which fully meets the above claim, not withstanding intended use of said composition.:

Claims 43 to 46 and 77 to 82 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Treat (4,027,512).

The above claims are clearly anticipated by the composition of this reference, not withstanding intended use of said composition. See col. 4 lines 42 to 48.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 43 to 63, 65 to 70 and 77 to 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bedague et al (3,871,837).

Patentee teaches a lubrication composition comprising at least one polyalkylene glycol polymer and a carboxylic acid. See col. 7 line 40 to col. 8 line 19. The polymer has an average molecular weight of about 600 to about 2,000.

Applicants claim a lubricant composition suitable for use in a conveyor system comprising a fatty acid and a polyalkylene glycol polymer or a derivative thereof. It is the examiner's position that the above claims would not be patentable over the prior art because the reference teaches a lubricant composition comprising the same components. While the reference uses the composition for a different lubrication purpose, this would not render the composition claims patentable. Intended use is of no avail in determining patentability of the composition per se.

Claims 1 to 30, 33, 34 and 38 to 42 are allowed.

Claims 31, 32 and 35 to 37 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J. V. Howard/mn
February 4, 2003